

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re Application of:

Gerard MOINET, et al.

Examiner: LAMBKIN, Deborah C.

Serial No.: 10/580,033

Group Art Unit: 1626

Filed: May 19, 2006

Title: ANTIDIABETIC COMPOUNDS COMPRISING BENZOFURAN AND
BENZOTHIOPHENE DERIVATIVES

RESPONSE TO ELECTION/RESTRICTION REQUIREMENT

Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450

Sir:

In response to the Office Action mailed on April 5, 2007, applicants elect with traverse Group II, claims 1-27, drawn to compounds, compositions, processes and method of formula I wherein X is S and R1-R6 do not contain a het group. As a species applicants elect with traverse the first compound of Table A, which is claimed in claim 16 as the first compound, i.e., ethyl 3-[2-(4-chlorophenyl)-2-oxoethoxy]benzo[*b*]thiophene-2-carboxylate. The traversal is on the basis that the PTO has not established that it would pose an undue burden to examine the full scope of the application.

As to the Election of Species Requirement, applicants remind the USPTO of M.P.E.P. 803.02, which states that, should no prior art be found which renders the invention of the elected species unpatentable, the search of the remainder of the generic claim(s) should be continued in the same application. Since the decisions in *In re Weber*, 580 F.2d 455, 198 USPQ 328 (CCPA 1978) and *In re Haas*, 580 F.2d 461, 198 USPQ 334 (CCPA 1978), it is improper for the Office to refuse to examine that which applicants regard as their invention, unless the subject matter in a claim lacks unity of invention. See MPEP 803.02 in accord.

No fee is believed to be due with this response; however, the Commissioner is hereby authorized to charge any fees associated with this response or credit any overpayment to Deposit Account No. 13-3402.

Respectfully submitted,

/Csaba Henter/

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Attorney Docket No.: Merck-3172

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